

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the amendments to the claims and the following remarks. Claims 1, 4-9 and 12 are pending. Claims 1, 4, 7, 9, and 12 are amended. Claims 2, 3, 10, 11, 13 and 14 are canceled. No new matter is involved. Basis for the amendments to claims 1, 4, 9, and 12 is found throughout Applicant's originally filed disclosure including the originally filed claims and, for example, on page 6 of the Application as originally filed, which states that the multimedia service can be effectively provided to the client on the network with the maximum number of sessions according to the operating situation of the server.

Reconsideration of claims 1, 4-9 and 12, as amended, is respectfully requested.

§103 REJECTIONS

Claims 1-14 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lumelsky, et. al. (USP 6,516,350, hereinafter "Lumelsky") in view of U.S. Patent 6,484,257 to Ellis. Applicant respectfully traverses this rejection.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir.

1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. §103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all

the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Claim 1, as amended, recites a method of maximizing the number of sessions according to an operating situation of a server for a multimedia service in a network environment in which the server and a plurality of clients are connected with each other and the server dynamically decides whether to provide or not provide multimedia service sessions according to a request of a client. Neither of the applied references appears to perform this positively recited method. In fact, neither applied reference even mentions maximizing the number of sessions according to the operating session of a server. As noted in Lumelsky’s abstract, Lumelsky is directed to assigning clients across global and local resources, and coordinates placement of replicas of target content across global resources. While Lumelsky discloses negotiations, nowhere does Lumelsky disclose or suggest maximizing the number of sessions according to the operating situation of a server for a multimedia service, as recited

Similar comments apply to claim 4, which positively recites an apparatus for maximizing the number of sessions according to an operating situation of a server for a multimedia service in a network environment in which the server and a plurality of clients are connected with each other and the server provides a multimedia service sessions according to a request of a client, as recited.

Similar comments apply to claim 9, which positively recites a method for a server for maximizing the number of sessions according to an operating situation of the server for a multimedia service in a network.

Similar comments apply to claim 12, which positively recites a server for maximizing the number of sessions according to an operating situation of the server for a multimedia service in a network.

The Office Action relies on col. 15, lines 32-37 and col. 16, lines 1-22 of Lumelsky. This broad expanse of Lumelsky is not detailed disclosure, but is a listing of Lumelsky's claims 1-5, and no claim mentioned or addresses the claimed feature of maximizing the number of sessions according to an operating situation of a server for a multimedia service in a network environment in which a server and a plurality of clients are connected with each other and the server provides multimedia service sessions according to a request of a client.

Moreover, Applicant's claimed invention is not are disclosed or suggested by the broad summary in Lumelsky's col. 5, lines 46-48 of Lumelsky's service control plane guaranteeing a client's performance when the client accepts a mapping recommendation.

Furthermore, as pointed out in Applicant's previous remarks filed, for example, on July 6, 2005, there is absolutely no mention in Lumelsky of evaluating whether the server is to

generate a new session to provide a multimedia service from the server according to the request by the one client, as recited. In fact, the only mention of a "session" in Lumelsky is found in Col. 14, lines 49-54, which states that a final aspect of his invention is directed to a Resource Management Framework (RMF) which is an extensible, distributed, policy-based, object-oriented management framework that supports per-flow media session setup and control between one or more media servers and end users and may augment the SCP. The RMF is disclosed in more detail in Serial No. 09/335,275, which is now U.S. Patent 6,529,950, which Lumelsky incorporates by reference. Applicant has reviewed U.S. Patent 6,529,950 and cannot find anywhere in the '950 patent a disclosure or suggestion of the server generating a new session to provide a multimedia service from the server according to the request by the one client, as recited. In fact, the '950 patent is directed primarily to negotiated mapping sessions instead of to the claimed invention.

Applicant thanks the Examiner for discussing this argument on page 7 of the Office Action by referring to the combination of Lumelsky and Ellis.

The present rejection relies on Ellis for a teaching of the determination of a new session based on current available processor bandwidth, with reference to the Timing Model disclosure in cols. 7 and 8 of Ellis. The Office Action states that this teaching is obviously representative of a policy/property within Lumelsky and that the claims are found to be unpatentable over the combined teachings of Lumelsky and Ellis.

Applicant respectfully disagrees with this conclusion for a number of reasons.

Firstly, neither Lumelsky nor Ellis are directed to maximizing the number of sessions according to the operating situation of the server for a multimedia service in a network and,

therefore, do not render the claimed invention obvious even if one of ordinary skill in the art were properly motivated to combine them.

Secondly, the Office Action does not explain how Ellis is to be used to modify Lumelsky. Instead, it merely indicates that Ellis discloses a specific means by which processor resources and client requests are determinative of a new session generation. It is not clear how Lumelsky is to be modified or what aspect of Lumelsky is to be modified.

Thirdly, Ellis only discloses denying a connection based on configuration settings (col. 7, lines 36-39), not on whether the allocated resources are not receivable in one of the capability negotiation steps, or sufficient resources are not available, as recited.

Merely that the prior art can be modified in the manner suggested by the Examiner does not render the modification obvious unless the prior art suggests the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir. 1992). Lumelsky contains no such suggestion and the Office Action fails to provide objective factual evidence of record of any such suggestion. It is well settled that a factual inquiry to modify a reference must be based on objective evidence of record, not merely on conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As Lumelsky fails to even suggest maximizing the number of sessions according to the operating situation of a server for a multimedia service in a network environment in which the server and a plurality of clients are connected with each other, the motivation for modifying Lumelsky to include such a feature must be based on speculation and/or impermissible hindsight.

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to modify Lumelsky in view of Ellis to achieve the invention recited in independent claims 1, 4,

9 and 12, and the claims that depend from claim 4, including the rejected dependent claims 5-8, and thus, fails to make out a *prima facie* case of obviousness of the claimed invention.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-14 under 35 U.S.C. §103(a) as unpatentable over Lumelsky in view of Ellis are respectfully requested.

CONCLUSION

All rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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